

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed January 24, 2006. Claims 1-6, 8-26 and 28-35 remain pending. Reconsideration and reexamination are respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-18 and 20-26 remain rejected as being anticipated by Melchione et al. (US 5,930,764). In response to Applicants' previous amendments and arguments, the Examiner asserts that the new language added with the previous amendment introduces the art of distributing workload, which is taught by Melchione et al. as the list of leads is sent to branch offices and then to personal bankers. Applicants respectfully disagree. Independent claim 1 recites a method in which customized listings of customers are provided that include a listing of the selected customers that the particular representative represents. Applicants submit that this method step is not met by a list of leads being distributed among personal bankers in a branch office, as suggested by Melchione et al. In Melchione et al. the branch managers appear to assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers. See, for example, Melchione et al., column 9, lines 46-52. This, however, appears to not have anything to do with providing customized listing of customers that include a listing of the selected customers that the particular representative represents. As noted above, claim 1 recites a method in which a customized listing of customers is provided to selected representatives and the list includes customers that the representative represents. Applicants submit that the claimed method step is not met by Melchione et al.

Additionally, claim 1 recites the method step of "determining which or how many of the customers that were sent the marketing material by their representative actually purchased the product." This step requires determining which or how many of the customers were sent the marketing material, as well as determining which of those customers actually purchased the product. Melchione et al. do not appear to teach tracking which particular customers were contacted, or which of those customers that were actually contacted and provided with marketing

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material actually purchased the product. Instead, Melchione et al. appear to merely track daily sales information for the bankers. Tracking only daily sales information, as suggested by Melchione et al., would not appear to provide a true indication of the efficacy of the marketing project, because, for example, it may include customers that were contacted but did not receive the marketing materials, and/or customers that were not even contacted by a banker. For these and other reasons, claim 1 is believed to be clearly patentable over Melchione et al. For similar and other reasons, dependent claims 2-6 and 8-9 are also believed to be clearly patentable over Melchione et al.

Claim 10 is believed to be clearly patentable over Melchione et al. for similar reasons to those discussed above with respect to claim 1. As stated above, Melchione et al. do not appear to teach providing a customized listing of customers to selected representatives wherein each of the customized listings including the portion of the selected customers that are represented by the particular representative. Instead, Melchione et al. appear to teach a sort of random distribution of potential new leads to personal bankers in branch offices. That is, in Melchione et al. the branch managers appear to assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers. See, for example, Melchione et al., column 9, lines 46-52.

In addition, claim 10 recites that the marketing material is personalized to at least appear to be from the representative. Nothing in Melchione et al. appears to show this element. The Examiner asserts that Melchione et al. teach a method in which the banker looks up personal information on the customer in order to speak intelligently with the customer during the sales session, and that this is equivalent to personalizing the marketing material as recited in claim 10. Applicants respectfully disagree. Claim 10 recites the method step of the representatives providing marketing material that is "personalized to at least appear to be from the representative." The instant specification describes such a step as including, for example, formatting the material to be compatible with a merge function such that the representative may create personalized letters, envelopes, emails, and other marketing materials that are then provided to the customer. See specification at, for example, page 15, line 27 through page 16, line 11. Applicants submit that a banker reading an electronic file on a potential client prior to

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meeting with or speaking on the phone with that person is not equivalent to providing marketing material that is personalized to appear to be from a representative, as is recited in independent claim 10. Melchione et al. thus do not appear to teach each and every element of independent claim 10. For these and other reasons, dependent claims 11-24 are also believed to be clearly patentable over Melchione et al.

Specifically with respect to dependent claims 20-24, nothing in Melchione et al. appear to teach or suggest providing a customized listing to each representative, and more particularly, a customized listing to each of representative in the recited formats. In fact, since the personal bankers of Melchione et al. do not appear to send out marketing material to customers, but rather simply make phone calls, there would appear to be little need to provide a customized listing in a format that is compatible with, for example, printing labels, printing envelopes or post cards, a merge function of an application program, a spreadsheet application program, or an e-mail program.

The Examiner asserts that Melchione et al. teach targeted marketing techniques including direct mailing, telemarketing and computer banking, pointing to column 4, lines 8-37 for support. However, this portion of Melchione et al. is the background of the invention, where Melchione et al. describes such direct mailing and telemarketing techniques as having the disadvantage of not taking advantage of the information available to full service financial institutions. Melchione et al. thus appear to teach away from such techniques. Additionally, Applicants submit that the mere fact that Melchione et al. teach "the system includes means for downloading reports and files to local printers or storage devices" (column 8, lines 49-50) does not anticipate the specific steps recited in claims 20-24. For these additional reasons, dependent claims 20-24 are believed to be clearly patentable over Melchione et al.

Turning now to claim 25. Applicant notes that claim 25 was amended in the previous response. The Examiner has maintained the rejection of claim 25 as being anticipated by Melchione et al., ***but did not address the added elements or Applicants' previous arguments.*** Thus, the Examiner has necessarily failed to set forth a prima facie case of unpatentability for claim 25, as is required by the MPEP. Applicants thus respectfully request that the Examiner

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either withdraw the rejection of independent claim 25 and the claims dependent thereon, or provide a detailed response to the amended claim.

Melchione et al. do not appear to teach a method such as that recited in claim 25. Melchione et al. indicate that the personal bankers can receive access to the list of leads on the CCIS workstation, after the list is generated by the micromarketing center and communicated to the CCIS. The personal bankers then appear to conduct sales sessions (e.g., telephone calls) with each of the customers on the list of leads. See, for example, column 9, lines 53-57. Melchione et al. do not appear to teach or suggest a method in which a marketing project appeal indicator is determined by monitoring how many representatives review a notice announcing a marketing project, and then request a customized listing of their customers. For these and other reasons, claim 25 is believed to be clearly patentable over Melchione et al. For similar and other reasons, dependent claims 26 and 28-30 are also believed to be clearly patentable over Melchione et al. For similar and other reasons, newly presented claims 31-35 are also believed to be clearly patentable over Melchione et al.

The Examiner has taken Official Notice with respect to claims 14 and 18, asserting that the concept and advantages of determining common characteristics for customers that purchased or did not purchase the product are well known and expected in the art. Applicants submit that the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Per MPEP 2144.04(C), Applicants again respectfully traverse the taking of Official Notice and again request the Examiner provide documentary evidence in the next office action if the rejection is maintained.

The Examiner has maintained the rejection of claims 14 and 18 from the previous Office Action, and thus the Official Notice basis for the rejection. However, the Examiner has not addressed Applicant's previous request for documentary evidence supporting the rejection. Applicants again traverse the taking of Official Notice and request the Examiner provide the required documentary evidence in the next office action.

Rejection under 35 U.S.C. § 103(a)

Claims 19 and 31-35 are rejected as being unpatentable over Melchione et al. in view of

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17 CFR Part 24. Applicants respectfully traverse the rejection.

With respect to dependent claim 19, for at least the reasons stated above, Melchione et al. do not appear to teach each and every element of independent claim 10, from which claim 19 depends. 17 CFR Part 24 does not appear to provide what Melchione et al. lack. Thus, even if one were to combine Melchione et al. and 17 CFR Part 24, one would not arrive at the claimed invention. Additionally, there does not appear to be any motivation for combining the teachings of Melchione et al. and 17 CFR Part 24. Applicants submit that the mere presence of regulations relating to consumer privacy does not provide any motivation, guidance or suggestion for one of ordinary skill in the art to modify the method of Melchione et al. to achieve the method of claim 19.

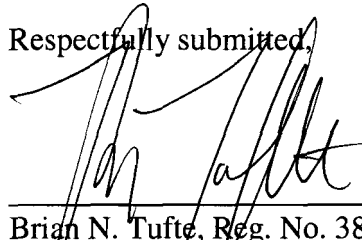
Regarding claims 31-35, the Examiner asserts that Melchione et al. teach providing compliant marketing material and a customized listing of the selected customers to at least some of the representatives, pointing to column 9, lines 44-52 for support. Applicants have reviewed this passage in Melchione et al., as well as the remainder of the document, and have found no such teaching. Melchione et al. do not appear to teach anything regarding checking marketing material for compliance with applicable rules and regulations. The Examiner then asserts that it would have been obvious to combine the customer marketing database system of Melchione et al. with the compliance features of 17 CFR part 248 to provide a more comprehensive and marketable system. Applicants submit that there is no motivation, suggestion, or guidance for one of ordinary skill in the art to make such a combination. As stated above, the mere existence of regulations relating to customer privacy does not provide any motivation for one to combine such regulations with the database of Melchione et al. The only motivation appears to be found in Applicants' specification, which is improper. Additionally, it is not clear how one would combine the regulations in 17 CFR part 248 with the method of Melchione et al. Further, even if one were to attempt to combine the regulations with the database of Melchione et al. one would not arrive at the specific method steps recited in independent claim 31, or the claims dependent thereon. Withdrawal of the rejection is respectfully requested.

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Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

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Respectfully submitted,



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